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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,222	04/18/2001	Yoshihiro Nakagawa	1080.1096/JDH	6419

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EXAMINER

PATEL, HARESH N

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/836,222

**Applicant(s)**

NAKAGAWA, YOSHIHIRO

**Examiner**

Haresh Patel

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-7 are presented for examination.

#### ***Response to Arguments***

2. Applicant's arguments filed 6/7/04 have been fully considered but they are not persuasive. Therefore, rejection of claims 1-7 is maintained.

Applicant argues (1) Turner, U.S. Pub. No. 2003/0177030 A1, (hereinafter Turner), does not disclose "a disclosure procedure executing section that ... transmits the information on the specific individual and the information disclosure items registered for the specific individual to the communication line network toward the information requesting origin when the information disclosure procedure has been satisfied", as cited in the amended claim 1. The examiner disagrees in response to applicant's arguments. As, applicant acknowledged that Turner provides a password associated with patient information and, thereby, using the password as authentication, page 6, lines 28 - 30, applicant's arguments, 6/7/04. Along with the password, other password necessary information is communicated to the individual, name of individual, individual ID, etc. Hence, Turner clearly teaches a disclosure procedure executing section that ... transmits the information on the specific individual (e.g., password, col., 2 paragraph 22 – col., 3 paragraph 30) and the information disclosure items (e.g., password necessary information, name of individual, individual ID, etc, col., 2 paragraph 22 – col., 3 paragraph 30) registered for the specific individual to the communication line network toward the information requesting origin when the information disclosure procedure has been satisfied (e.g., paragraph, 24, col., 2). As, applicant acknowledged that Turner also stores the individual (patient) information, which can

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be accessed by the patient himself using a password, page 7, lines 6 - 10, applicant's arguments, 6/7/04. Hence, the patient information, including medical records, is also considered as the information disclosure items, which is provided to the patient over the internet (e.g., paragraph, 24, col., 2), and which represents inherent limitation, transmitting "the information on the specific individual and the information disclosure items registered for the specific individual to the communication line network toward the information requesting origin when the information disclosure procedure has been satisfied". The claim is open-ended (comprising) and also, page 4, lines 1-30, represents, preferable modes of the invention described as preferred forms of implementing the claimed invention. Since, applicant's claims contain broadly claimed subject matter, it clearly reads upon the examiner's interpretation of these actions. Therefore, Turner meets the claimed limitations.

Applicant argues (2) "Turner and Platenghe, EP 0950972 A2, (hereinafter Platenghe), are improperly combined". The examiner disagrees in response to applicant's arguments. Both the cited references Turner and Platenghe teach what the applicant is trying to accomplish, i.e., the claimed invention by the usage of preamble "an individual information managing device connected to a communication line network, for managing individual information, the device comprising". Turner teaches the substantial claimed limitations of the claimed invention and clearly states, "Thus, those skilled in the art will appreciate the various modifications could be made to the disclosed embodiments without departing from the intended scope of the present invention", paragraph 46, col., 6, to accommodate teachings from other prior arts, for example, Platenghe teachings of handling a request at an emergency time. Also, The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure

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of a primary reference. It is also not that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 414, 425, 208 USPQ 871, 881 (CCPA 1981); In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). Therefore, Turner and Platenghe meet the claimed limitations.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 4-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Turner et al. US Publication 2003/0177030, Sep 18, 2003 (Hereinafter Turner).

5. As per claim 1, Turner teaches the following:

an individual information managing device connected to a communication line network, for managing individual information, the device comprising:

an individual information storing section in which information (e.g., password, col.,2, paragraph, 0022) and information disclosure items (e.g., individual password related information, ID, individual name and/or individual records, col.,2, paragraph, 0022), on each

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individual has been registered (e.g., In addition to test results or x-rays, data storage device 18 is intended to store messages posted regarding the patient and the course of treatment in case they are needed in the future, col.,2, paragraph, 0022),

a disclosure procedure storing section in which an information disclosure procedure assigned for each individual by each individual has been registered; and (e.g., Data storage device 18 is included to store patient information that is transmitted via information system 10. The four predetermined security levels illustrated in FIG. 2 determine the amount of access that users will be granted upon entry into information system 10. Once a patient is admitted to treatment center 11 for treatment of his or her particular ailment, one or more passwords are created to be used in conjunction with the patient's name col., 2 paragraph 22 – col., 3 paragraph 30, Hence, the created passwords that are associated with the patient information and they are stored in the data storage device 18 and used to access the patient information),

a disclosure procedure executing section that receives a request for disclosing information on a specific individual through the communication line network (e.g., server 12 running software such as VBISAM sold by software source, Inc for information management, col., 2, paragraph, 19, In addition to those terminals connected to server 12 by internal communication lines 26, information system 10 is designed to be accessed from off-site locations 30 via a publicly accessible computer network such as the Internet. For instance, a concerned party could access information system 10 from an off-site location 30. Server 12, which is also an Internet server, could be networked into a publicly accessible computer network to allow third party individuals to access information system 10 from locations outside of treatment center 10, paragraph, 23, col., 2),

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executes an information disclosure procedure that matches the information disclosure procedure of the specific individual stored in the disclosure procedure storing section, (e.g., This can be done either by activating a terminal at one of the computer workstations 15 located at treatment center 11 or by networking with server 12 via the unique Internet address assigned to patient information system 10. Upon connection to server 12, the user should encounter an identification screen (FIG. 8). To access patient information forum 20, the user will usually be required to input certain information, such as the patient's name, both first and last, and a password. This password will determine the level of access entitled to the user and will allow the user to pass through at least one of the security levels operably positioned between the computer input device and patient information forum 20, paragraph, 42, col., 5),

and transmits the information on the specific individual (e.g., password, col.,2, paragraph, 0022) and the information disclosure items registered for the specific individual (e.g., individual password related information, ID, individual name and/or individual records, col.,2, paragraph, 0022) to the communication line network toward the information requesting origin when the information disclosure procedure has been satisfied (e.g., For instance, the hospitalist and the referring physician could establish a dialogue in information system 10 via Internet communication lines 28 to exchange information regarding the patient, paragraph, 24, col., 2).

6. As per claim 2, Turner teaches the following:

the individual information storing section is registered with each individual information that consists of a plurality of ranked pieces of information for each individual (e.g., a database containing race, religion, etc information for each patient, figure 1 and 3), based on the

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arrangement that each individual assigns a rank to each of the pieces of information that constitute the individual information from among a plurality of ranks (e.g., race, religion, etc information for each patient entered during admission, figure 1 and 3),

the disclosure procedure storing section is registered with an information disclosure procedure according to each rank within each individual assigned by each individual (e.g., a database containing race, religion, etc information for each patient, figure 1 and 3), and the disclosure procedure executing section receives a request for disclosing information on a specific individual (e.g., staff requesting patients information based on race, figure 3), and executes an information disclosure procedure stored in the disclosure procedure storing section that matches an information disclosure procedure corresponding to a rank of the information on the specific individual of which disclosure request has been received (e.g., server 12 running software such as VBISAM sold by software source, Inc for information management and executing request, col., 2, paragraph, 19).

7. As per claim 4, Turner teaches the following:

the disclosure procedure storing section is registered with a posting procedure assigned by each individual for posting to an individual, as a part of an information disclosure procedure for each individual, the disclosure procedure executing section has a disclosure request posting section that receives a request for disclosing information on a specific individual, posts to the specific individual that there has been a request for disclosing the individual information, in a posting procedure that matches the posting procedure to the specific individual stored in the disclosure procedure storing section, and receives an approval for the information disclosure



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from the individual who has received this posting, and the disclosure procedure executing section receives an approval for the information disclosure from the disclosure request posting section, and further proceeds with the information disclosure procedure (e.g., Additionally, a means for posting information regarding a particular patient on the patient information forum is included, paragraph, 8, FIG. 6 is a diagrammatic representation of the message posting structure for responsible and non-responsible parties according to the present invention, FIG. 7 is a diagrammatic representation of the message posting structure for administration and staff members according to the present invention, col., 4 paragraph 36 – col., 5 paragraph 39).

8. As per claims 5 and 6, Turner teaches the following:

the disclosure procedure storing section is registered with an authentication procedure assigned by each individual for authenticating each individual,. as apart of an information disclosure procedure for each individual, the disclosure procedure executing section has an authenticating section that receives a request for disclosing information on a specific individual, and authenticates the specific individual an authentication procedure that matches the authentication procedure of the specific individual stored in the disclosure procedure storing section, after the disclosure procedure executing section has received an approval for the information disclosure of the specific individual from the disclosure request posting section (e.g., Clearance through the security levels is preferably obtained utilizing passwords assigned to a user at admission, in the case of a patient, or the initiation of employment, in the case of a caregiver or staff member of treatment center 11. For example, a treating physician may have a single password that allows total access to all patients in his or her care, etc. However, it should

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be appreciated that other security means could be substituted, such as security keycards.

Additionally, while four security levels have been illustrated, it should be appreciated that this number could vary to better meet the needs of the individual treatment center 11, paragraph, 25, col., 2).

9. As per claim 7, Turner teaches the following:

the disclosure procedure storing section can be freely registered with an authorized person to whom the right of proceeding with an information disclosure procedure on behalf of the individual has been transferred for each individual, the disclosure procedure executing section receives a request for disclosing information on a specific individual, and executes an information disclosure procedure of the specific individual stored in the disclosure procedure storing section that matches the information disclosure procedure of an authorized person as a procedure for disclosing the information on the specific individual, when the disclosure procedure storing section has been registered with the authorized person to whom the right of proceeding with the information disclosure procedure on behalf of the individual has been transferred (e.g., The patient, guardian or a person having power of attorney then determines who will be given the passwords, thus allowing the patient or other person with authority to determine who has access to information, and how much access that person should be allowed. For instance, a user who is permitted access into a first security level 50 might be a non-responsible third party. Members of this group could include anyone not having any legal responsibility for the patient, such as friends or distant relatives of the patient. Those gaining access to this security level might have the ability to leave questions for the patient and access answers to these

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questions. In addition, they might have general access to non-confidential discharge information and non-confidential background information regarding the treating physician. This party may not, however, be able to access more confidential information such as patient diagnosis information or treatment records, col., 3, paragraph, 26).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Turner in view of Platenghe, Cris. T European patent application, EP 0950972, 4/14/1999 (Hereinafter Platenghe).

12. As per claim 3, Turner teaches the following:

the disclosure procedure storing section is registered with an information disclosure procedure at a normal time for each individual assigned by each individual (e.g., This would allow the concerned party to access current information and/or leave questions at any time of day or night from any off-site location, paragraph, 23).

However, Turner does not specifically mention about handling a request at an emergency time.

Platenghe teaches the following:

an information disclosure procedure at an emergency time for each individual assigned by each individual, the disclosure procedure executing section receives a request for disclosing

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information on a specific individual, with attached information for identifying a normal time and an emergency time, and executes an information disclosure procedure of the specific individual stored in the disclosure procedure storing section that matches the information disclosure procedure at a normal time or the information disclosure procedure at an emergency time, depending on whether the disclosure request belongs to the normal time or the emergency time (e.g., A system and method for securely storing data provides for storing, managing, and updating an owner's secret data and for accessing the stored data by a trusted third party upon the occurrence of an event, such as the death of the owner, abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Turner with the teachings of Platenghe in order to facilitate a caring person to access the information of an individual during the emergency time. The caring persons to provide necessary help to the person in emergency situations can use the secure but necessary information of an individual.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is (703) 605-5234. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee, can be reached at (703) 305-8498.

The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Haresh Patel

October 24, 2004

A handwritten signature in black ink, appearing to read 'Haresh Patel', with a long, sweeping horizontal line extending to the right.